

pending continuation or divisional thereof. A copy of the '229 patent is provided herewith for the Examiner's convenience.

Pursuant to 37 C.F.R. §1.607(a)(2), Applicants present the following proposed count: a process for producing a stable oxidizing bromine composition, selected from the group consisting of the processes according to Claim 1 of Application No. 09/451,319 and Claim 10 of U.S. Patent No. 1,156,229.

Applicants submit that Claims 10-17 of the '229 patent correspond to the proposed count. Claims 61-65 of the instant application correspond to the count and are supported by the Specification as follows:

| <u>Claim</u> | <u>Support</u> |
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| <p>61. A process of producing a concentrated stabilized biocidal composition which</p> <p>comprises <u>mixing bromine</u> with an <u>aqueous alkali metal sulfamate solution formed from water, sulfamic acid and alkali metal base,</u></p> <p>wherein the pH of said aqueous alkali metal sulfamate solution is such that the pH of the resultant biocidal composition is from about 12.0 to about 14.0</p> | <p>Page 5, line 14, describes a stabilized bromine composition</p> <p>Page 5, lines 1-4 and 10, describe making an aqueous solution by mixing in water, sulfamic acid and an alkali metal base, then adding bromine to this solution.</p> <p>Page 4, line 17 and page 6, line 6, describes a pH range of 12 to 14.</p> |
| <p>62. A process according to Claim 61 wherein the solution is cooled.</p> | <p>Page 13, lines 13-21, describe cooling the solution.</p> |

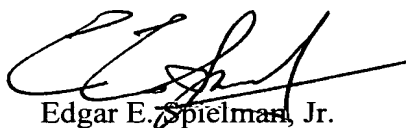
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| <p>63. A process according to claim 62 wherein the solution is cooled so that the temperature is from 30°C to about 60°C.</p> | <p>Page 13, lines 13-21, describe maintaining the temperature of the solution between 30°C and 60°C.</p> |
| <p>64. A process according to Claim 61 wherein said bromine is added in sufficient amount to obtain an active bromine content of at least about 100,000 (wt/wt) and the atom ratio of nitrogen to active bromine is greater than 1.</p> | <p>Page 4, lines 18-20, describe a composition having these characteristics.</p> |
| <p>65. A process according to Claim 61, wherein the pH is from about 12.0 to about 13.5.</p> | <p>Page 4, lines 17-18, describe a pH range of 12.0 to 13.5.</p> |

As indicated above, Claims 1 to 5 find clear support in the present application. In addition, each corresponds to the count, as do each of the claims of the '229 patent. Although slightly different terminology is used in the application and the '229 patent, both disclose the same patentable invention--methods for producing stabilized, concentrated aqueous solutions of biocidally active bromine. Applicants note that, as presently worded, all of the claims of the '229 patent are invalid under 35 U.S.C. §112, ¶1 because the caustic solution recited in the first paragraph of independent Claims 10 and 17 (Column 8, line 64 to Column 9, line 10 and Column 9, line 33, to Column 10, line 14) cannot simultaneously contain an alkali or alkaline earth hydroxide and an acid stabilizer (e.g., sulfamic acid), yet such an anomaly is expressly permitted by several of the choices for the "halogen stabilizer" recited in Claim 10 and Claim 17. If these infirmities in the '229 claims are corrected, for example, in a reissue application or a continuing application to specify an invention that is physically possible and supported by the '229 specification, then a reissue of the '229 patent will claim the same patentable invention as is claimed in the instant application.

Claim 10 of the '229 patent, the broadest interfering claim in the patent, otherwise differs somewhat in scope from Claim 1 of the instant application, largely in reciting a step of "cooling the solution" (Column 9, line 10). But this cooling step is essentially meaningless because the claims does not recite when or how cooling occurs (e.g., during or after mixing), to what temperature, at what cooling rate, and the like.

The subject matter of Claim 1, the broadest claim in the instant application, is described and supported in patent application Serial No. 09/088,300, filed June 1, 1998. The parent application issued as U.S. patent No. 6,068,861 ("861 patent"). A copy of the '861 patent is provided for the Examiner's convenience. Support for Claim 1 is found, for example, in Column 2, line 64, to Column 3, line 3; and Column 4, lines 27-28. Thus, Applicants have demonstrated continuous written description support from the ultimate parent application to the present application for at least one species within the proposed count, and, therefore are entitled to priority over the '229 patent which is entitled to a filing date no earlier than June 29, 1998.

Respectfully submitted,



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MAILING CERTIFICATE

I hereby certify that in accordance with the standard business practice, this paper (along with any referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, Washington, DC 20231.

April 11, 2001
Date of Signature

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